



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/984,979 12/04/97 BAER

T 17726-709

MM92/0314

JOHN J BRUCKNER
WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO CA 94304

EXAMINER

NGUYEN, T

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 03/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/984,979

Applicant(s)
Baer et al.

Examiner
Tu Nguyen

Group Art Unit
2877



☒ Responsive to communication(s) filed on Dec 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-48 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-48 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 & 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 8

Serial Number: 08/984,979

Filing Date: 12/04/97

Detailed Office Action

Election/Restriction

Applicant's election with traverse of the restriction in Paper No. 7 is acknowledged. The traversal is on the ground(s) that it is not appear to be a "serious burden" to the examiner. This is not found persuasive because the embodiments in applicant's invention are drawn to different classes. For example: group I (claims 1-44) drawn to a laser capture microdissection apparatus, classified in class 356/244 and group II (claims 45-48), drawn to a microscope, classified in class 359/363. Group I and II are directed to different classes so it requires examiner to do more search.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,16,31 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the claims are drawn to a laser capture microdissection apparatus but they do not have any mechanical to perform the laser microdissection such as: a laser, a sample holding,

Claims 11-12,15,26-27,30,41-42,44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear that claims 15,30,44 are dependent or independent.

In claims 11,12,26-27,41-42, it is not clear how the LCM film has a thickness that is within 20%. The 20% compare to what? The problem also the same to claims 12,27,42.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371⁶ of this title before the invention thereof by the applicant for patent.

Claims 16,31 are rejected under 35 U.S.C. 102(e) as being anticipated by Baer et al. (WO 98/35215).

With respect to claim 16, Baer discloses a laser capture microdissection (LCM hereinafter) apparatus comprising: a transfer film carrier having a substrate surface (fig 1b, 14), a LCM transfer film (fig 1b, 16) coupled to the carrier.

With respect to claim 31, Baer discloses a LCM assembly comprising: a plate having a top surface (fig 7, 44), a LCM cap couple to the plate comprising: a carrier (fig 7, 40) coupled to the transfer film (fig 7, 42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15,17-30,32-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al (WO 98/35215).

Baer discloses a LCM apparatus comprising: a transfer film carrier having a substrate surface (fig 1b, 14), a LCM transfer film (fig 1b, 16) coupled to the carrier.

With respect to claims 1,13-14,28-29, Baer discloses the claimed invention except for the integrally formed structure. Using the integrally formed structure for controlling the space between the transfer film and the sample is well known in the art so it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Baer's apparatus with the integrally formed structure to control the spacing to reduce the system cost.

With respect to claims 2-4,17-19,37, the transfer film in Baer's invention is made from thermoplastic (lines 15-21) so it inherent include all the claimed limitations.

With respect to claims 5,20,38, LCM transfer film is hot vacuum baked (lines 7-17, page 12).

With respect to claims 6,21, Baer discloses the claimed invention (page 8, lines 15-21) except for not explicitly mention about the refractive index of the glue. Using the glue with has the same refractive index with the substrate would have been a design choice because on page 8,

lines 19-20, Baer teaches that the film can be fastened to the cap by any known fastening means so the limitation would have been a design choice.

With respect to claims 7,22,39, the diameter of the transfer film in Baer's invention is greater than the diameter of the transfer film (fig 7, 42).

With respect to claims 8-9,23-24, the claimed girdle would have been inherent (fig 7).

With respect to claim 10,40,25, Baer's LCM transfer film thickness is less than 500 microns (page 8, lines 20-21).

With respect to claims 11-12,26-27,41-42, Baer discloses the claimed invention except for the range of the transfer film thickness and flatness. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to choose any range for the film thickness or flatness, since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Because claims 15, 30, 44 do not have any specific structure so any LCM apparatus can read on the claims.

With respect to claims 32-34, Baer's release layer (fig 7, 46) is located between the transfer film and the plate (fig 7), made by nonadhesive material consisting of silicon and ethylene (page 12, lines 11-12 and page 8, lines 17-19).

With respect to claim 35,43 the Plano-concave void and the diffuser would have been a design choice.

With respect to claim 36, the prior art LCM film is a transparent ethylene vinyl acetate polymer thermoplastic film.

Papers related to this application may be submitted to TC 2877 by facsimile transmission. Papers should be faxed to TC 2877 via the PTO Fax Center located in CP4-4C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Center number is (703)308-7722.

If the Applicant wishes to send a Fax dealing with either a Proposed Amendment or for discussion for a phone interview then the fax should:


- a) Contain either the statement "DRAFT" or "PROPOSED AMENDMENT" on the Fax Cover Sheet; and
- b) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Tuan Nguyen whose telephone number is (703) 306-9185.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Tu Tuan Nguyen
Patent Examiner
TC 2877
March 11, 2000/TTN


Frank G. Font
Supervisory Primary Examiner
Group Art Unit 2877